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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,712	04/05/2006	Alfio Borghese	X-16289	5430
25885	7590	10/05/2007		EXAMINER
ELI LILLY & COMPANY PATENT DIVISION P.O. BOX 6288 INDIANAPOLIS, IN 46206-6288				MABRY, JOHN
			ART UNIT	PAPER NUMBER
			1609	
				NOTIFICATION DATE
				DELIVERY MODE
			10/05/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/574,712	BORGHESE ET AL.
	Examiner	Art Unit
	John Mabry	1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 50,51 and 54-70 is/are pending in the application.
  - 4a) Of the above claim(s) 52 and 53 is/are withdrawn from consideration.
- 5) Claim(s) 54-62 is/are allowed.
- 6) Claim(s) 50,51,63-70 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/05/06</u>	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 50-51 and 54-70 are drawn to compounds, pharmaceutical compositions and process of making thereof of Form IV and V.
- II. Claims 52 and 53 are drawn to compounds (2-chlorophenyl)-[2-(2-hydroxy-2-pyridinyl-4-yl-vinyl)pyridinyl-3-yl]methanone and a salt thereof and (2-chlorophenyl)-[2-(2-hydroxy-2-pyridinyl-4-yl-vinyl)pyridinyl-3-yl]methanone phosphate.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical

features...those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The special technical feature corresponding to Group I is compounds of Form IV and V, pharmaceutical compositions and a process thereof is the triazole structural core. Group II has the special technical feature corresponding to compounds (2-chlorophenyl)-[2-(2-hydroxy-2-pyridinyl-4-yl-vinyl)pyridinyl-3-yl]methanone and (2-chlorophenyl)-[2-(2-hydroxy-2-pyridinyl-4-yl-vinyl)pyridinyl-3-yl]methanone phosphate which are enol and corresponding phospho-enolate pyridines. These structural systems are not considered equivalent.

Therefore the above claims, are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a common core structure and the technical features present fail to define a contribution over the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to only one invention.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Election***

During a telephone conversation with Manisha Desai on September 28, 2007, a provisional election was made without traverse to prosecute the invention of Group I, claims 50-51 and 54-70. Affirmation of this election must be made by applicant in replying to this Office action. Claims 52-53 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Thus, the restriction requirement is deemed proper and FINAL.

### **Specification**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Crystalline forms of {2-[1-(3,5-bis-trifluoromethyl-benzyl)-5-pyridin-4-yl-1h-[1,2,3] triazol-4-yl]-pyridin-3-yl}-(2-chlorophenyl)-methanone.

The novelty of the invention is decided by the USPTO, not the Applicant. The Examiner suggests that the Applicant please reconsider re-naming of title.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 63-70 are rejected under 35 U.S.C. 102(a) as being anticipated by Amegadzie et al (WO 03/091226 A1).

The reference teaches {2-[1-(3,5-bistrifluoromethylbenzyl)-5-pyridin-4-yl-1H-[1,2,3]triazol-4-yl]-pyridiin-3-yl}-(2-chlorophenyl)-methanone as a treatment of central nerve diseases (see page 124, Example 132).

Applicant is claiming a pharmaceutical composition comprising the above-mentioned compound as the polymorph (crystalline) form in a pharmaceutically acceptable carriers, e.g. water. If the polymorph is placed in any liquid pharmaceutically acceptable carrier, the compound will not retain it crystalline form, and thus, is anticipated by Amegadzie et al.

The Examiner suggests the insertion of the word “solid” in front of “composition” in claims 63 and 67 to overcome the rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amegadzie et al (WO 03/091226 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome

by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The instant claims discloses crystalline of Form IV and V, {2-[1-(3,5-bistrifluoromethylbenzyl)-5-pyridin-4-yl-1H-[1,2,3]triazol-4-yl]-pyridiin-3-yl}-(2-chlorophenyl)-methanone.

***Scope & Content of Prior Art MPEP 2141.01***

Amegadzie et al disclose crystallize compound {2-[1-(3,5-bistrifluoromethylbenzyl)-5-pyridin-4-yl-1H-[1,2,3]triazol-4-yl]-pyridiin-3-yl}-(2-chlorophenyl)-methanone (see page 124, Example 132).

***Differences between Prior Art & the Claims MPEP 2141.02***

Amegadzie et al differs from the instant claims in that the reference discloses the recrystallized product, {2-[1-(3,5-bistrifluoromethylbenzyl)-5-pyridin-4-yl-1H-[1,2,3]triazol-4-yl]-pyridiin-3-yl}-(2-chlorophenyl)-methanone, but does not show the X-ray powder diffraction and solid-state  $^{13}\text{C}$  NMR data. The instant application claims crystalline form of said product with said data.

***Prima Facie Obviousness, Rational & Motivation MPEP 2142-2413***

Amegadzie et al produced the product, {2-[1-(3,5-bistrifluoromethylbenzyl)-5-pyridin-4-yl-1H-[1,2,3]triazol-4-yl]-pyridiin-3-yl}-(2-chlorophenyl)-methanone from recrystallization from a mixture of ethylacetate/hexanes (see page 124, line 14). The instant application teaches the use of “anti-solvents” such as isopropanol, acetone, acetonitrile, propanol, butanol, and ethylacetate to crystallize crystalline Form IV and V (see page 13, lines 4-11 of Specification). It would be obvious to one of ordinary skill in the art at the time of the invention to crystallize said product from just ethylacetate to obtain crystalline Forms IV and V.

Additionally, due to the recrystallization of said product from ethylacetate/hexanes as taught by Amegadzie, the instant claimed crystalline Forms IV and V would inherently exist.

The reference shows the compound, but is silent on the particular crystalline form. MPEP 2112 states:

"Something which is old does not become patentable upon the discovery of a new property.

The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977)."

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 54-62 contains allowable subject matter. The intermediates are novel, thus the process is novel and free of art.

***Conclusion***

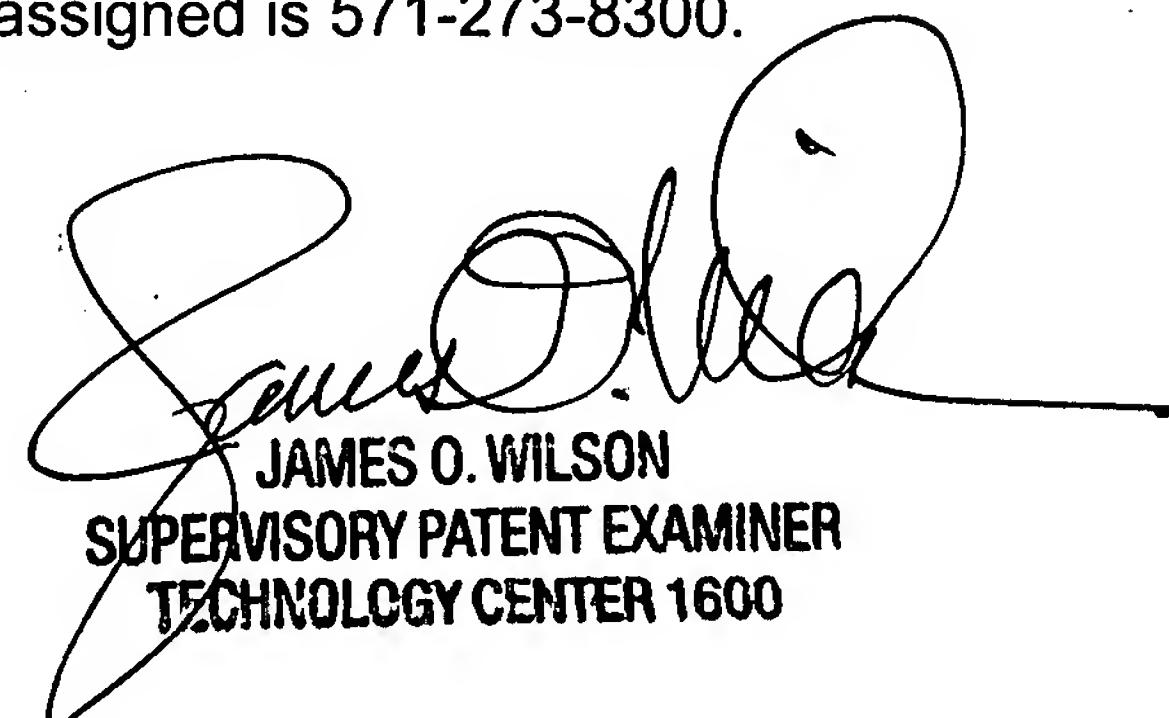
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

*jm*

JM



JAMES O. WILSON  
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